

### REMARKS

Reconsideration of the application is respectfully requested.

Claims 6, 7, 11-16, 21, 22, 24-28, and 30-77 are pending. The Office action dated September 8, 2003, rejected claims 6, 7, 11-16, 21, 22, 24-28, and 30-77 over various combinations of references, which Applicants have grouped as they appear in the Office action.

Group 1: In sections 2-10 of the Office action, claims 6, 7, 13, 14, 25-28, and 42 were rejected as being anticipated by U.S. Patent Application Publication No. US 2003/005463 to Macrae et al. ["Macrae"].

Group 2: In sections 11-18 of the Office action, claims 6, 7, 11-14, 25, 26, and 31-34 were rejected as being unpatentable over U.S. Patent No. 6,335,736 to Wagner et al. ["Wagner"].

Group 3: In sections 19-26 of the Office action, claims 6, 7, 11-15, 25, 26, and 31-34 were rejected as being unpatentable over U.S. Patent No. 5,929,849 to Kikinis et al. ["Kikinis"].

Group 4: In sections 27-35 of the Office action, claims 6, 7, 11-15, 25, 26, 31-34, 42, and 43 were rejected as being unpatentable over U.S. Patent No. 6,075,568 to Matsuura ["Matsuura"].

Group 5: In sections 36-38 of the Office action, claims 15, 16, 21, 22, 24, 30-32, 35-39, and 45 were rejected as being obvious in view of Macrae.

Group 6: In sections 39-56 of the Office action, claims 11, 12, 15, 16, 21, 22, 24, 30-39, 41, 43-48, 52-57, 60-63, 65, 67-71, 74, 76, and 77 were rejected as being unpatentable over Macrae in view of U.S. Patent No. 5,929,850 to Broadwin et al. ["Broadwin"].

Group 7: In sections 57-75 of the Office action, claims 11, 12, 15, 16, 21, 22, 24, 30-39, 45-50, 52-56, 60-63, 66-70, 72, 74, and 77 are rejected as being unpatentable over Macrae in view of Matsuura.

Group 8: In sections 76 and 77 of the Office action, claims 40, 51, 58, 64, 73, and 75 were rejected as being unpatentable over Wagner in view of U.S. Patent No. 6,058,430 to Kaplan ["Kaplan"].

**I. The Macrae U.S. application publication is not prior art.**

Macrae is not prior art to the present application. Any rejection that relies in full or in part on Macrae should be withdrawn.

First, the present application is a pre PG-PUB application, and the pre-AIPA version of §102(e) applies to the application. Macrae is a U.S. application publication, which is not a prior art category under pre-AIPA §102(e). Moreover, even if the application of the Macrae publication

issued as a U.S. patent, the effective date of the patent under pre-AIPA §102(e) would be the date of completion of §371(c)(1)(2) and (4) requirements, which appears to be September 30, 1999. The U.S. patent would still not be prior art under §102(e). (MPEP 706.02(a))

Even under revised §102(e), Macrae would not qualify as a §102(e) reference. The Macrae U.S. application publication results from and claims the benefit of an international application with a filing date of October 16, 1997. Since the international filing date is before November 29, 2000, no U.S. application publication resulting from or claiming the benefit of the international application may be applied as a §102(e) reference. Further, a Macrae U.S. patent would still have as its effective date the date of completion of the §371(c)(1)(2) and (4) requirements. (See "Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (Revised<sup>1</sup>)," 1266 Official Gazette 77, p. 8-9 and 14-15, copy provided with previous amendment.)

Macrae is also not prior art under §102(a) for the present application. As a §102(a) reference, the effective date of Macrae is the date of publication of the U.S. application publication – January 2, 2003 – which is after the filing date of the present application.

Applicants respectfully request withdrawal of the rejections in Groups 1 and 5-7, which each rely in full or in part on Macrae. Claims 16, 21, 22, 24, 27, 28, 30, 35-39, 41, 44-50, 52-57, 59-63, 65-72, 74, 76, and 77 (which were not otherwise rejected) should be allowable.

## **II. The rejections in view of Wagner should be withdrawn.**

In sections 11-18 of the Office action, claims 6, 7, 11-14, 25, 26, and 31-34 were rejected as being unpatentable over Wagner. Applicants respectfully disagree.

### **A. Wagner**

With the goal of reaching a shared understanding of the disclosure of Wagner, Applicants make the following observations.

Wagner describes a graphical user interface ["GUI"] for a television set-top box. [Wagner, Abstract.] The GUI provides a way of notifying a user when interactive content can be accessed in relation to material on the television screen. Specifically, when the availability of interactive content is detected by the set-top box, a window 40 is opened in the corner of the display screen 30.

[Wagner, 6:18-42, Figures 6 and 7.] The window 40 includes a small, animated character 41 which moves in order to gain the user's attention. [*Id.*]

Elsewhere, Wagner describes a browser panel 31 with icons for control buttons 31, 32, and 34A-34E. [Wagner, 1:55-65, 5:19-38.] Wagner thus recognizes differences between the animated on-screen notification 41 in the window 40 and icons (as in the browser panel 31).

**B. Claims 6, 7, 11-14, 25, 26, and 31-34**

Claim 6 recites:

in response to link data conveyed with the television signal, displaying with the displayed television signal an icon, said icon indicating the availability of associated auxiliary data from the auxiliary data network; and  
responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.

Wagner fails to teach or suggest the above-cited language of claim 6. Wagner describes a set-top box that reacts when the availability of interactive content is detected. [Wagner, 6:18-42, Figures 6 and 7.] In such cases, the set-top box opens a window 40 in the display screen 30, where the window 40 includes a small, animated character 41 which moves in order to gain the user's attention. [*Id.*] This is different than and leads away from the use of an icon as recited in claim 6, and is even further away from the timing of actions involving the icon of claim 6. In fact, Wagner describes the use of icons elsewhere for other purposes [*see* Wagner, 1:55-65, 5:19-38], reinforcing the point that the animated character 41 in the window 40 is not an icon, and further leading away from the above-cited language of claim 6.

Claim 6 should be allowable. In view of the foregoing discussion of claim 6 and Wagner, Applicants will not belabor the merits of the separate patentability of claims 7, 11-14, 25, 26, and 31-34. Claims 7, 11-14, 25, 26, and 31-34 should also be allowable.

**III. The rejections in view of Kikinis should be withdrawn.**

In sections 19-26 of the Office action, claims 6, 7, 11-15, 25, 26, and 31-34 were rejected as being unpatentable over Kikinis. Applicants respectfully disagree.

**A. Kikinis**

With the goal of reaching a shared understanding of the disclosure of Kikinis, Applicants make the following observations.

Kikinis describes a system that receives a data stream having image frame data and URL data between the frame data. [Kikinis, Abstract.] The URL data for a given frame is associated with an icon or image entity in the frame. [Kikinis, 3:25-31, 5:18-26, 6:53-57.] The icon/image entity is displayed on the video display. [Kikinis, 4:35-40, 5:18-26, 6:50-63; see icon 57 in Figure 2A.] When the icon/entity is selected by user input (such as with the cursor 70 in Figure 2C), the system retrieves the Web page content referenced by the associated URL and displays the content, for example, in window 71 of Figure 2C. [Kikinis, 4:41-46, 7:57-8:22, 9:44-65.]

**B. Claims 6, 7, 11-15, 25, 26, and 31-34**

Claim 6 recites:

responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.

Kikinis fails to teach or suggest the above-cited language of claim 6. According to Kikinis, when an icon/image entity is selected by user input (such as with the cursor 70 in Figure 2C), the Kikinis system accesses the Web page content referenced by the associated URL and displays the content, for example, in window 71 of Figure 2C. [Kikinis, 4:41-46, 7:57-8:22, 9:44-65.] This involves going directly from the display of the icon/entity to retrieval and display of the Web page content, which leads away from the above-cited language of claim 6.

Claim 6 should be allowable. In view of the foregoing discussion of claim 6 and Kikinis, Applicants will not belabor the merits of the separate patentability of claims 7, 11-15, 25, 26, and 31-34. Claims 7, 11-15, 25, 26, and 31-34 should also be allowable.

**IV. The rejections in view of Matsuura should be withdrawn.**

In sections 27-35 of the Office action, claims 6, 7, 11-15, 25, 26, 31-34, 42, and 43 were rejected as being unpatentable over Matsuura. Applicants respectfully disagree.

**A. Matsuura**

With the goal of reaching a shared understanding of the disclosure of Matsuura, Applicants make the following observations.

Matsuura describes a data broadcast receiver and network system associated with a network such as the Internet. [Matsuura, 1:7-9.] The system switches between display of either the TV signal (through terminal T1), character data (through T2), or information from the Internet (through

T3). [Matsuura, 5:4-15.] The receiver receives broadcast signals in which a video signal is transmitted together with a data signal (including character data and Internet addresses). [Matsuura, 2:16-26, 3:38-45, 5:39-46.] The receiver separates the data signal and determines whether the data signal includes Internet addresses. [Matsuura, 2:16-26, 3:45-60, 5:39-53.] When character data is displayed, an Internet address associated with that character data may also be *textually displayed over the character data*. [Matsuura, 4:9-19, 6:1-38, Figure 3.] Internet addresses are stored in memory and (if directed by the user) put in an address list. [Matsuura, 2:44-48, 4:45-54, 5:54-62, 6:39-57.]

The user switches from viewing the character data to browsing the Internet using a control device. [Matsuura, 6:61-7:13.] The system switches directly to viewing/browsing Internet content. [*Id.*] The user may also select from the address list. [Matsuura, 7:18-52.] First, the user causes display of the current address list. [*Id.*] Then, the user selects an address from the list, and browsing from the selected address is initiated. [Matsuura, 7:61-8:2.]

**B. Claims 6, 7, 11-15, 25, 26, 31-34, 42, and 43**

Claim 6 recites:

in response to link data conveyed with the television signal, displaying with the displayed television signal an icon, said icon indicating the availability of associated auxiliary data from the auxiliary data network; and  
responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.

Matsuura fails to teach or suggest the above-cited language of claim 6 for several reasons.

First, Matsuura fails to teach or suggest “displaying with the displayed television signal an icon, said icon indicating the availability of associated auxiliary data from the auxiliary data network.” Matsuura describes displaying an Internet address textually, which is different than and leads away from displaying an icon as recited in claim 6.

Second, Matsuura describes displaying the Internet address over character data (through terminal T2), which is different than displaying over the television signal (through T1) in Matsuura. For this reason as well, Matsuura leads away from the above-cited language of claim 6.

Third, Matsuura fails to teach or suggest “responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.” Matsuura describes switching directly from display of character data/Internet address to display for Internet browsing, which is different than and leads

away from the above-cited language of claim 6. Matsuura also describes using an address list, but that also does not teach or suggest the timing of the actions recited in claim 6.

Claim 6 should be allowable. In view of the foregoing discussion of claim 6 and Matsuura, Applicants will not belabor the merits of the separate patentability of claims 7, 11-15, 25, 26, 31-34, 42, and 43. Claims 7, 11-15, 25, 26, 31-34, 42, and 43 should also be allowable.

V. **The rejections in view of Wagner and Kaplan should be withdrawn.**

In sections 76 and 77 of the Office action, claims 40, 51, 58, 64, 73, and 75 were rejected as being unpatentable over the combination of Wagner and Kaplan. Applicants respectfully disagree.

Claim 40 depends from claim 6. Claim 6 recites:

in response to link data conveyed with the television signal, displaying with the displayed television signal an icon, said icon indicating the availability of associated auxiliary data from the auxiliary data network; and  
responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.

Wagner and Kaplan, taken separately or in combination, fail to teach or suggest the above-cited language of claim 6. Specifically, Wagner and Kaplan, taken separately or in combination, fail to teach or suggest the timing of *displaying* a graphical control panel *responsive to a signal* from a viewer *during displaying an icon*. As discussed in section II, Wagner does not teach or suggest at least one limitation in claim 6.

Kaplan, in turn, describes display of an icon to indicate that a valid URL has been received. [Kaplan, 5:1-9.] A user can then request (e.g., by pressing a key on a remote control) that an Internet subsystem (12) make a connection as specified by the URL. [Kaplan, 5:14-20.] The connection process is initiated immediately after receiving such a request from the user. [Kaplan, 5:20-23.] Kaplan's immediate initiation of the connection process after receiving the request from the user [Kaplan, 5:20-23] leads away from the above-cited language of claim 6.

Claim 40 should be allowable.

Claims 51, 58, and 64 depend from independent claims 16, 21, and 30, respectively. Claims 73 and 75 depend directly or indirectly from independent claim 35. The Examiner has not articulated any bases for rejecting independent claims 16, 21, 30, and 35 in view of Kaplan or Wagner. Claims 51, 58, 64, 73, and 75 should be allowable.


**CONCLUSION**

Claims 6, 7, 11-16, 21, 22, 24-28, and 30-77 in their present form should now be allowable.  
Such action is respectfully requested.

Respectfully submitted,

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